

Appln No. 10/820,480
Amdt date September 10, 2009
Reply to Office action of June 10, 2009

REMARKS/ARGUMENTS

In the Final rejection dated June 10, 2009, the Examiner maintained the rejection of claims 1-30 under 35 U.S.C. §103(a) as allegedly obvious over Moaddeb, et al. (U.S. Patent No. 6,405,078) in view of Skalsky, et al. (U.S. Patent No. 4,844,099). In maintaining this rejection, the Examiner argues that "[i]t is improper for [A]pplicant to assume that the [Skalsky] electrode must be used in the same manner (i.e. to attach to tissue) when combined with the [Moaddeb] reference," and that "[t]he skilled artisan would not be required to use [the Skalsky] construction in the exact same manner and would realize that any porous electrode may be fabricated in [the Skalsky] manner and continue to be used for its intended purpose." Office action, page 4. Applicant respectfully traverses this rejection.

As noted in MPEP §2143.02, obviousness requires a reasonable expectation of success, which can be shown if "all the claimed elements were known in the prior art *and* one skilled in the art could have combined the elements as claimed by known methods *with no change in their respective functions*, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art." Here, the combination of Moaddeb and Skalsky would result in a significant *change in the respective functions* of the claimed elements. In particular, as noted in Applicant's previous responses, Skalsky discloses a pacing lead that is designed to remain in the heart. In order to accomplish this, the Skalsky lead is designed to facilitate attachment of the lead to tissue by promoting tissue ingrowth. See column 2, line 54 to column 3, line 8. Given this disclosure in Skalsky, those of ordinary skill in the art would have predicted that the Skalsky structure would promote tissue ingrowth. As the catheter disclosed in Moaddeb is designed for temporary use during a relatively short procedure, a structure such as that described in Skalsky that promotes tissue ingrowth would significantly alter the function of the Moaddeb device.

Moreover, as Skalsky is directed to a pacing lead that attaches to tissue through tissue ingrowth, those of ordinary skill in the art would have predicted that replacing the electrode of Moaddeb with a structure similar to that described in Skalsky would result in a structure that attaches to tissue through tissue ingrowth. As such, those of ordinary skill in the art looking for

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ideas to improve the Moaddeb catheter would not have predicted any beneficial result from the modification suggested by the Examiner. Indeed, those of ordinary skill would predict that the resulting device would attach to tissue through tissue ingrowth, significantly altering the function of the Moaddeb device. Accordingly, those of ordinary skill in the art could *not* have combined the elements *with no change in their respective functions*, and the combination would *not* have yielded any predictable, beneficial results. Therefore, those of ordinary skill in the art would not have combined Moaddeb and Skalsky in the manner suggested by the Examiner, and claims 1-30 are allowable over those references.

Claims 1-30 remain pending in this application. By this amendment, Applicant has amended independent claims 1, 15, 29 and 30 to remove the recitations that the non-conductive porous material is configured to avoid substantial contact with the tissue and that the conductive porous coating (or thin metal coating) is adapted cover *a circumferential surface* of the non-conductive porous material. As those of ordinary skill in the art would not be motivated to combine Moaddeb and Skalsky, Applicant submits that these limitations are not necessary for patentability. The amendments find full support in the original specification, claims and drawings, and no new matter is presented. In light of the above amendments and remarks, Applicant submits that all of pending claims 1-30 are in condition for allowance. Applicant therefore respectfully requests reconsideration and a timely indication of allowance. However, if there are any remaining issues that can be addressed by telephone, Applicant invites the Examiner to contact Applicant's counsel at the number indicated below.

Respectfully submitted,

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